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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,950	04/09/2001	Masahiro Nakano	SOA-330	6685

23353 7590 05/03/2006	EXAMINER
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036	BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/827,950	NAKANO, MASAHIRO
	Examiner	Art Unit	
	KIEU-OANH T. BUI	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 February 2006*.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18,20 and 21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-18,20-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Appeal Brief

1.   In view of the Appeal Brief filed on February 13, 2006, PROSECUTION IS HEREBY

REOPENED. A new office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between

the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below:

JOHN MILLER   JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Remark

2.   Applicant's arguments with respect to claims 1-18, and 20-21 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-4, 6-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kung et al. (U.S. Patent No. 6,373,817 B1) in view of Wong et al. (U.S. Patent 6,968,364

B1).

Regarding claim 1, Kung discloses "an apparatus for filtering electronic mail and

notifying a user, residing in a set top box connected between a television content provider, an

Internet provider having an e-mail server, and a television" (Fig. 1, for users at terminals 142 or

wireless 144 or <u>users at CPE Home 102 –a set top box- with an integrated broadband residential</u>

<u>gateway BRG 300 interface or module (Fig. 3, with P1-P6 are processors for processing software</u>

<u>program applications, refer to col. 21/line 54 to col. 22/line 36)</u> receiving contents including e-

mails from the Internet 180 via an Internet provider or Administration 155 connected to an IP

central station 200, with a television content provider at head end hub 115, terminals including a

television, a set top terminal or a set top box, refer to col. 4/lines 22-60 & col. 19/lines 9-26),

comprising: a software program application which enables a user specify filter criteria and notification icons which then retains and stores said e-mail filter criteria and icons; a querying module contained within said software program application which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server (Figs. 7a, 8 & 10 for a software program allowing the user to define and set up a calling schedule for himself/herself or a calling preference in filtering e-mail or message intended for him/her and for the server to know whether to retain and store the message, see Fig. 2 and col. 13/lines 7-26 for a multimedia server 222 for e-mail supports; col. 34/line 20 to col. 35/line 5 for chase me feature; and col. 35/line 44 to col. 36/line 35 for filtering and scheduling of calls or messages); and a notifying module also contained within said software program application wherein, upon arrival of an e-mail fulfilling said criteria, said application notifies the user by posting said notification icons to the set box, i.e., col. 29/lines 27-44 for a query addressed; and col. 30/lines 15-31 for call or message alerting; and col. 23/lines 4-22 for an instant message included.

Kung does not clearly show the presence of a querying module contained within the software program application which queries the e-mail server to determine whether e-mail fulfilling the e-mail filter criteria has arrived at the e-mail server; and a notifying module also contained within the software program and the notification the user by posting the notification icon to the set top box; however, Wong teaches the same technique as Wong's set top box (Fig. 2 and col. 11/lines 20-62) containing software application including querying module and identifying module for querying, filtering, and displaying the notification icon to the set top box (Figs. 3-4 for modules within the client device, and 15/line 32-col. 16/line 20 & col. 16/line 63 to col. 17/line 57; Figs. 5-7 for e-mail notification icons and col. 19/line 7-col. 20/line 45 for

notification whether the user accepts an e-mail or not; with Figs. 12-13 for e-mail server; and

Fig. 16 for a computer routine in identifying and/or filtering messages based on predetermined

criteria as well as link to server for the user request and programming data is receiving based on

querying procedure; Fig. 17 is further for filtering process, see col. 38/line 31 to col. 9 & col.

40/line 13-55). Therefore, it would have been obvious to one of ordinary skill in the art to

modify Kung's system with Wong's features in e-mail filtering technique as disclosed in order to

obtain an apparatus for filtering e-mail and notifying user as indicated.

As for claims 2 and 3, Kung discloses "wherein the connection between said set top box

and said mail server is permanent, so that said application continually queries said e-mail server"

and "wherein the connection between said set top box and mail server is non-permanent, so that

said application queries said e-mail server at specific timed intervals", i.e., depending on the

user's preference whether to receive the e-mail or message notification from the server

continually or at specified time intervals, the application is performing as shown in Figure 10

whether to accept the message or filter the message at any time of day and any day of week (Fig.

10, and col. 35/line 44 to col. 36/line 35).

As for claim 4, Kung further discloses "wherein said set top box contains an multi-

tasking Operating System and said application runs on top of said Operating System" (col.

21/line 34 to col. 22/line 25 for a multi-tasking operating system).

As for claims 6 and 7, Kung shows "wherein said application further includes means for

notifying the user of the existing e-mail messages fulfilling said e-mail filter criteria through a

notification icon on the television screen" and "wherein said notification icon is configurable by

the user, and reflects the content of the e-mail filter criteria" (col. 22/line 37-col. 23/line 22 for status screen with icons and messages or e-mail notifications).

As for claims 8 and 9, Kung further discloses "wherein said application further includes means for notifying the user through the use of an tone generated through the television speaker" and "wherein said tone is configurable by the user, and reflects the content of the e-mail filter criteria" (col. 22/line 37-col. 23/line 22 for status screen with icons and messages or e-mail notifications; and col. 30/lines 15-30 for audio tones alerts).

As for claim 10, Kung shows "wherein said notifying means notifies the user of a plurality of said e-mail messages wherein each e-mail message satisfies different filter criteria and has a different user notification icon" (Figs. 7a & 7b & 8 for different filter criteria; and col. 22/line 45-63 for different icons addressed).

As for claim 11, Kung discloses "wherein said application further includes means for querying said e-mail server upon power-up of said set box, and immediately notifies the user of the existence any e-mail messages satisfying the user-specified e-mail filter criteria" (col. 30/lines 15-52 as notification is delivered to the user as soon as the off-hook network connection-power off- is connecting to the network again).

As for claim 12, Kung discloses "wherein said application notifies the user via a pager rather than through said set top box" (col. 38/lines 13-36 for pager and notification to the user's pager).

As for claim 13, Kung discloses "wherein said application notifies the user of the existence a telephone call with Caller ID satisfying said filter criteria, instead of an e-mail message" (col. 22/lines 37-49 for caller ID).

As for claim 14, Kung discloses "wherein said application notifies the user of another user attempting to make Instant Message contact with said first user" (col. 22/line 58 to col. 23/line 22 for instant message addressed).

As for claim 15, Kung shows "wherein newer versions of said application are downloaded to said set top box by said Internet provider" (col. 36/lines 5-35 as missing plug-ins or software can be downloaded to the set top box from the service provider).

As for claim 16, Kung discloses "wherein said downloading of newer versions can distinguish between different types of set top boxes, and make adjustments to content said download accordingly", i.e., each user of the set top or terminal has their own ID for billing purposes and ordering including authentication for use within the network, see col. 12/lines 1-15; And col. 36/lines 18-35 as newer versions or new plug-ins or software can be requested and charged or free of charge based on available services from the service provider.

As for claims 17 and 18, Kung shows "wherein said application is not resident on said set top but resident on said e-mail server" and "wherein said set top box is connected to said e-mail server through a middle server, where said application resident on said middle server" (Fig. 2 shows an IP central control with multimedia server 222 for e-mail as noted above; and the process is performed at the IP central station, see col. 7/line 35 to col. 8/line 60).

(Claim 19 is canceled).

Regarding claim 20, Kung discloses "an e-mail filtering and notification application, comprising: a set top box, connected between TV content provider, an Internet provider having an e-mail server, and a user-input means for allowing a user specify e-mail filter criteria and notification icons; retaining and storing means for retaining and storing said criteria and icons;

querying means, for querying said e-mail server to determine whether e-mail fulfilling said user

criteria has arrived at said e-mail server; notification means for notifying the user said arrival by

posting said notification icons the Set Top Box, wherein said notification icons relate to the

subject matter of said arriving email" (refer to claim 1 above). Kung does not clearly show the

presence of a querying module contained within the software program application which queries

the e-mail server to determine whether e-mail fulfilling the e-mail filter criteria has arrived at the

e-mail server; and a notifying module also contained within the software program and the

notification the user by posting the notification icon to the set top box; however, Wong teaches

the same technique as Wong's set top box (Fig. 2 and col. 11/lines 20-62) containing software

application including querying module and identifying module for querying, filtering, and

displaying the notification icon to the set top box (Figs. 3-4 for modules within the client device,

and 15/line 32-col. 16/line 20 & col. 16/line 63 to col. 17/line 57; Figs. 5-7 for e-mail

notification icons and col. 19/line 7-col. 20/line 45 for notification whether the user accepts an e-

mail or not; with Figs. 12-13 for e-mail server; and Fig. 16 for a computer routine in identifying

and/or filtering messages based on predetermined criteria as well as link to server for the user

request and programming data is receiving based on querying procedure; Fig. 17 is further for

filtering process, see col. 38/line 31 to col. 9 & col. 40/line 13-55). Therefore, it would have

been obvious to one of ordinary skill in the art to modify Kung's system with Wong's features in

e-mail filtering technique as disclosed in order to obtain an apparatus for filtering e-mail and

notifying user as indicated.

Regarding claim 21, Kung discloses "an software application for filtering electronic mail and notify a user, residing on a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising: said software program application enabling a user to specify e-mail filter criteria and notification icons which then retains and stores said e-mail filter criteria and icons; a querying module which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; a notifying module wherein, upon arrival of an e-mail fulfilling said criteria, said application notifies the user by posting said notification icons to the set top box" (refer to claim 1 above for the teaching features of Wong's).

5.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S. Patent No. 6,373,817 B1) in view of Wong et al (US Patent 6,968,364 B1) and Skinner et al. (U.S. Patent No. 6,397,167 B2).

Regarding claim 5, Kung does not suggest the step of "wherein said set top box contains an single-tasking Operating System and said application remains memory as a Terminate and Stay Resident (TSR) program and runs intermittently at user-configurable intervals"; however, Skinner teaches a same technique in using TSR program for memory applications within the set top box, and the user controls and runs intermittently at user-configurable intervals (see Skinner, col. 8/line 43 to col. 10/line 36 for windows applications and TSR programs addressed). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kung's system with Skinner's detailed technique in TSR programs in order to provide applications to the system at the user's configurable intervals, for instance, at the user's keystroke or input as taught by Skinner.

Conclusion

6.   **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

7.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to (Krista) Kieu-Oanh Bui whose telephone number is (571) 272-7291. The

examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John W. Miller, can be reached at (571) 272-7353.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kieu-Oanh Bui
Primary Examiner
Art Unit 2623

KB
April 25, 2006